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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/985,793	11/06/2001	Masanori Nakamura	040679-1390	4343

22428 7590 10/27/2003

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

WRIGHT, WILLIAM G

ART UNIT	PAPER NUMBER
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1754

DATE MAILED: 10/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/985,793

Applicant(s)

NAKAMURA ET AL.

Examiner

William G. Wright SR.

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-- **The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 9-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-12 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 1-8 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen '745, file No. 09/834,505.

Chen teaches a layered gas treatment catalyst composition using alumina, noble metals, rare earth, alkali metals and

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alkaline earth metals. Claims 44 and 86 each teach the specific use of a second platinum group metal. The second platinum group metal is listed in the claims and includes rhodium. The specific teaching of the first layer having less of what the applicant refers to as "at least one metal" and the second layer having more of the same metals is found in claim 29 parts (a)IV and (b)II. The teaching of what a SO_x sorbent is is found at claim 41. Claim 105 teaches SO_x sorbents of MgO and barium oxide. Thus the top layer having more of the "at least one metal" component is well taught in the reference.

Claims 1-8 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto et al. '213.

Yamamoto teaches a layered gas purifying catalyst having a hydrocarbon absorbent layer and a metal-based catalyst layer on a monolithic support. The underlying layer is the hydrocarbon absorbent layer and the metal catalyst layer is the overlying layer. The taught ratios of each layer's content of alkaline metals and other metals taught in claims 5 and 6 are found in the Abstract and claims. Both layers teach catalytic elements and both teach, what the applicants refer to as "at least one metal". The top layer (metal catalyst layer) is taught to contain more of the elements at bar by way of the taught ratios.

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The specific use of larger than 10% found in instant claim 8 and the specific use of a sufficient amount in line 3 of claim 12 is not found in the applied reference. The use of the same compositions for the same functions is noted and, In re Best, 195 USPQ 430 (CCPA 1977) is cited to teach that the claimed nature of elements and compositions are inherent. The same or substantially the same compositions would be expected to have known properties absent a showing of a newly discovered function or property.

The claiming of the 10% limitation in claim 8 and the sufficient amount in claim 12 would be an obvious expedient left to a practitioner to adjust performance of the catalyst to a specific environment and desired result.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,589,901 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap in scope with subject matter claimed.

Claims 1-8 and 12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of copending application Serial No. 10/315,058. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap in scope of subject matter claimed.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments filed August 7, 2003 have been fully considered but they are not deemed to be persuasive.

The applicants argue that the content of the compound of the at least one metal in the second layer (the layer on the first catalytic layer) is larger than that in the first catalytic layer. This limitation is taught in claim 1 and also in claim 8 by other words. The limitation of the at least one metal being

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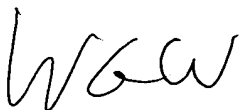
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present in a high concentration in the top layer is well taken against all of the outstanding rejections except the outstanding rejection over Chen '745, 09/834,505 which has been modified and maintained. Other new rejections are now of record and accordingly this action is a non-final rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William G. Wright, Sr. whose telephone number is (703) 305-7792. The examiner can normally be reached on Monday through Thursday from 6:30 A.M. to 5:00 P.M.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on (703) 308-3837. The fax phone number for the organization where this application or proceeding is assigned are (703) 872-9306 for the regular communications and (703) 872-9311 for after final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1495.



W. G. Wright, Sr.:cdc

October 17, 2003



STEVEN BOS
PRIMARY EXAMINER
GROUP 1100